

### **SUMMARY OF EXAMINER INTERVIEW**

Applicants would like to thank the Examiner for granting an interview on February 9, 2009, and for considering the arguments regarding the deficiencies of the cited references. During the interview, Applicants initially addressed the rejections under 35 U.S.C. §§ 101 and 112. An agreement was reached that the proposed amendments overcome the § 101 rejections recited in the Office Action, but that further consideration of each amended claim would be required to assess the pending § 112 rejections. Also during the interview, differences between independent claim 17 and the cited references were discussed. Differences, as indicated by the Applicants' representative, between claim 17 of the present application and the cited reference that were discussed during the telephonic interview are described in further detail in the remarks below. Though the interview was fruitful, agreement on this claim was not reached.

### **REMARKS**

Applicants respectfully request reconsideration of the present Application. Claims 1-2, 4, 9, 14-15, 17-18, 20-22, 25-33, 35, 37, and 39 have been amended herein. Further, claims 3, 13, 19, and 38 have been canceled herein. Care has been exercised to introduce no new matter. Claims 1-2, 4-6, 9-12, 14-15, 17-18, 20-22, 25-33, 35, 37, 39-40, and 42-43 stand pending and are in condition for allowance.

#### **Rejections based on 35 U.S.C. § 101**

Claims 17-22, 25-33, 35, 37-40, and 42-43 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action rejected independent claims 17-22, 25-33, and 35 as being directed “to software alone without claiming the associated computer hardware required for execution.” Office Action, p. 2. As an initial matter, Applicants note that the cancellation of claim 19 has mooted the rejection of this claim. Regarding the presently pending claims, Applicants have amended claim 17 to recite “[o]ne or more computer-readable storage media on which are stored machine instructions including instructions for a notification system.” Similarly, Applicants have amended claim 25 to recite “[o]ne or more computer-readable storage media on which are stored machine instructions including instructions for a user context system.” Applicants submit these amendments recite associated computer hardware (e.g., the computer-readable storage media), and therefore clearly render the rejected claims statutory. As such, Applicants respectfully request withdrawal of the rejections of claims 17-18, and 20-22, 25-33, and 35.

The Office Action also rejected claims 37-40 and 42-43 as being directed to non-statutory subject matter for lacking utility. *Id.* at 3. The Office Action submitted that the claimed computer-readable media “failed to indicate what permits the computer-useable

instruction to be realized.” Applicants disagree with this conclusion but, in the interest of advancing prosecution, have amended the rejected independent claim. Applicants note that the cancellation of claim 38 has rendered the rejection of this claim moot. Further, independent claim 37 now recites “computer-readable storage media” having “a set of computer-usable instructions for a computer-implemented method.” Applicants respectfully submit that “[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.” MPEP § 2106.01. Moreover, the recitation in claim 37 of “a computer-implemented method” necessarily includes a computer to implement or execute the method or system. Therefore, after this amendment, the necessary structure and performing element are clearly recited, and these claims are now undoubtedly statutory. As such, Applicants respectfully request withdrawal of the rejection of claims 37, 39-40 and 42-43.

#### **Rejections based on 35 U.S.C. § 112**

Also in the Office Action, claims 25-33, 35, and 37<sup>1</sup> were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 25 and 37 were rejected for including the phrase “the sender” that lacked antecedent basis. Office Action, p. 3. Additionally, claim 25 was also rejected for multiple occurrences of the phrase “a notification.” Applicants have corrected the identified issues, and respectfully request withdrawal of these rejections.

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<sup>1</sup> The Office Action did not list claim 37 as being rejected in the heading of ¶ 8. Independent claim 37, however, was identified in ¶ 8a. Applicants presume that claim 37 was rejected under 35 U.S.C. § 112, and welcome appropriate correction if they are mistaken.

Applicants note that the Office Action stated that “[t]here are too many error[s] to list individually, applicant is reminded to use consistent term to properly refer to the antecedent and fix all errors in the amendment.” Office Action, p. 4. Applicants have reviewed the claims, but are unable to ascertain the exact errors the Office Action referred to. As such, Applicants respectfully request greater specificity regarding the concerns expressed in the Office Action.

**Rejections based on 35 U.S.C. § 103(a)**

In the Office Action, claims 1-4, 6, 9-15, 17-20, 22, 25-30, 32, 35, 37-40, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beyda, U.S. Publication No. 2003/0229722 (hereinafter “Beyda”), in view of U.S. Patent No. 5,828,882 to Hinckley (hereinafter “Hinckley”). Moreover, claims 5, 21, 31, 33, and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beyda and Hinckley further in view of U.S. Patent No. 5,428,784 to Cahill (hereinafter “Cahill”). Applicants respectfully traverse these rejections, as hereinafter set forth.

**A. Applicable Authority**

To sustain a rejection of a claim under 35 U.S.C. § 103(a), the Examiner must find that a preponderance of the evidence supports a finding of obviousness. The Examiner bears the initial burden of showing that the reference teachings establish a prima facie case of obviousness. “In view of all factual information, the examiner must . . . make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” MPEP § 2142 (explaining that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”). In making that determination, the Examiner must consider every word in each claim. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Recently, the Supreme Court indicated that “it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art . . . to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007). However, if the references do not “expressly or impliedly suggest the claimed invention,” the examiner must present “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP § 706.02(j) and § 2142, quoting *Ex parte Clapp*, 227 USPQ 972, 972 (Bd. Pat. App. & Inter. 1985).

**B. Beyda in view of Hinckley fails to teach or suggest each and every limitation of rejected claims 1 and 9, as amended herein, and therefore fails to support a rejection under 35 U.S.C. § 103(a)**

Again, the Office Action rejected claims 1 and 9 as being obvious over Beyda in view of Hinckley. As the proposed combination fails to teach or suggest each and every limitation of independent claims 1 and 9, as each has been amended herein, Applicants respectfully traverse these rejection as hereinafter set forth.

Independent claim 1 is generally directed to a method for registering a process in a system where communication events occur that are related to notifications. The method includes receiving a message to register a process for communication events. The method also includes, in response to receiving the message, registering the process. The registered process is a program that has data regarding a user that is outside data maintained by other components of the system. The method also includes, when a communication event occurs, evaluating a sender according to selected criteria to determine whether the registered process will send a customized

message to the sender. The evaluation of the sender includes a determination of whether or not the sender has been placed on a list of persons entitled to receive the customized message.

In contrast, Beyda discusses various manners for processing an instant message. Beyda, Abstract. In general, Beyda teaches determining a rule governing how to process an instant message, receiving an instant message, and processing the instant message according to the rule. *See id.* at FIG. 2, ¶¶ [0032]-[0044]. Each rule contemplated in Beyda may include a rule identifier, a rule action, a destination for action, a timer, and a rule application. *See id.* at FIG. 3, ¶ [0045]. As detailed below, however, the Beyda reference fails to teach the claim limitation that the “registered process is a program that has data regarding a user that is outside data maintained by other components of a system.”

As an initial matter, Applicants note that the Office Action admits that “Beyda does not specifically teach the software process as a registered process, more specifically, a process being registered as a result of receiving a message to register the process for communications events.” Office Action, p. 5. Despite this obvious deficiency of the Beyda reference, the Office Action rejected claim 3 (whose limitation is now substantially embodied in amended claim 1) based upon Beyda disclosing the claim limitation that the “registered process is a program that has data regarding a user that is outside data maintained by other components of a system.” *See id.* at 5-6. Applicants note that since Beyda fails to teach or suggest the general limitation of a registered process, *see* Office Action, pp. 4-5, it is axiomatic that Beyda fails to teach or suggest the more specific limitation of a registered process being a program that has data regarding a user that is outside data maintained by other components of the system. In view of this deficiency, Applicants respectfully submit that Beyda fails to teach or suggest each and every limitation of independent claim 1, as amended herein.

In addition to the foregoing, Applicants submit that even if Beyda taught or suggested a registered process (which it obviously does not, *see* Office Action, pp. 4-5), Beyda clearly fails to teach or suggest the claim limitation that the “registered process is a program that has data regarding a user that is outside data maintained by other components of a system.” The Office Action asserted that Beyda discloses this claim limitation because the “software program for determining rule has data regarding the user (i.e., availability of the user based on time elapsed) is separate from the instant message client software.” *See* Office Action, p. 6. However, the timer of the Beyda middleware fails to teach or suggest the claimed limitation for several reasons. First, the timer fails to include data regarding the user, as claimed. On the contrary, a timer merely measures the amount of time between two events. In this circumstance, the timer measures the time between receipt of an instant message and some triggering event (i.e., rule). The counted time fails to reveal anything whatsoever regarding the user (e.g., where the user is, when the user will return, etc.). Second, the timer of Beyda fails to disclose data regarding a user that is outside data maintained by other components of a system. Rather, the “data regarding the user” putatively disclosed in Beyda is information readily available to any component of the system (i.e., elapsed time, idle time, etc.). As such, Beyda simply fails to teach or suggest each and every limitation of independent claim 1, as amended herein.

Hinckley fails to cure these deficiencies of the Beyda reference. Hinckley discusses an event notification facility including an interface by which programs register for notification of an event. Hinckley, Abstract. Hinckley clearly fails to disclose the claim limitation that the “registered process is a program that has data regarding a user that is outside data maintained by other components of a system.” In fact, Hinckley was not cited as disclosing

this limitation in the Office Action. As such, Applicants submit that Hinckley fails to cure the deficiencies of the Beyda reference.

Independent claim 9 is generally directed to a method for registering a process in a user context system. The method of independent claim 9 includes sending a message for registering a process. The registered process being a program that has data regarding the user that is outside the data maintained by the other components of the system. The method also includes, when a communication event occurs, evaluating a sender according to selected criteria to determine whether the registered process will send a customized message to the sender. The evaluation of the sender includes a determination of whether the sender has been placed on a list of persons entitled to receive the customized message. The method further includes providing the registered process with information regarding the communication event.

For at least the reasons provided above with regard to independent claim 1, Applicants submit that the proposed combination of Beyda in view of Hinckley fails to teach or suggest each and every limitation of independent claim 9, as amended herein. For instance, the proposed combination of Beyda in view of Hinckley fails to disclose the claimed "registered process being a program that has data regarding the user that is outside the data maintained by the other components of the system."

In view of the foregoing, Applicants submit that Beyda in view of Hinckley fails to teach or suggest each and every limitation of independent claims 1 and 9, as each is amended herein. As such, the combination of Beyda and Hinckley fails to support a rejection under §103, and Applicants respectfully request a withdrawal of the same. Similarly, each of claims 2, 4-6, 10-12, and 14-15 depend, either directly or indirectly, from one of allowable independent claims 1 and 9. Further, these dependent claims also recite other novel and nonobvious features neither



taught nor suggested by the cited references in the context of these claims. As such, Applicants submit these claims are also in a condition of allowance, by virtue of their dependency from an allowable independent claim. *See, e.g.*, MPEP § 2143.03.

C. **Beyda in view of Hinckley fails to teach or suggest each and every limitation of rejected claims 25 and 37, and therefore fails to support a rejection under 35 U.S.C. § 103(a)**

The Office Action also rejected independent claims 25 and 37 as being obvious over Beyda in view of Hinckley. As the proposed combination fails to teach or suggest each and every limitation of amended claims 25 and 37, Applicants respectfully traverse these rejections as hereinafter set forth.

Independent claim 25, as amended herein, is generally directed to one or more computer-readable storage media on which are stored machine instructions including instructions for a user context system. The user context system includes a first process for setting a user context and at least one user rule. The user context and the at least one user rule are made available to a user for modification in accordance with at least one preference of the user. The user context system also includes a second process for generating a notification. The user context system further includes a third process that is registered. The registered third process receives an event message in response to the notification not being delivered to the user. A sender of the notification is evaluated according to selected criteria to determine whether the registered third process will send a customized message to the sender when the notification does not reach the user. The evaluation of the sender includes a determination of whether the sender has been placed on a list of persons entitled to receive the customized message.

In the Office Action, independent claim 25 was rejected for the same reason as claims 1 and 17. Office Action, p. 7. Moreover, the Office Action noted that “Beyda as

modified teaches a process for setting a user context. [paragraph 2, lines 15-22].” *See id.* The cited portion of the Beyda reference discusses how, in a typical instant messaging system, a user may communicate with another user who is online. Beyda, ¶ [0002]. Moreover, the cited passage discloses how a user’s “buddy list” is updated when the user signs on and/or “budd[ies]” sign off or on. *See id.*

Applicants respectfully submit that this discussion of the Beyda reference fails to disclose the claimed “a first process for setting a user context.” In the interest of advancing prosecution, however, Applicants have amended independent claim 25 to more clearly distinguish over the Beyda and Hinckley combination. In particular, independent claim 25 now recites “a first process for setting a user context and at least one user rule, the user context and the at least one user rule are made available to a user for modification in accordance with at least one preference of the user.”

Applicants respectfully submit that the Beyda reference fails to teach or suggest at least this limitation of amended claim 25. Similarly, Applicants submit that Hinckley fails to disclose at least this limitation. Simply put, neither Beyda nor Hinckley disclose a process for setting a user context and at least one user rule, as used within the perspective of this claim. As such, Applicants respectfully submit that the combination of Beyda in view of Hinckley fails to teach or suggest each and every limitation of independent claim 25, as amended herein, and therefore fails to support a rejection based on § 103.

Independent claim 37 is generally directed to one or more computer-readable storage media for providing information regarding communication events, at least one communication event occurring when a notification is not delivered to a user. Claim 37 recites a set of computer-usable instructions for a computer-implemented method that cause a request to

provide a communication event to a process that is registered for communication events to be communicated to one or more other computer-program segments capable of executing said request. Further, and in response to receiving the communication event, the registered process evaluates a sender of the notification to determine if a customized message will be sent. The evaluation of the sender includes a determination of whether or not the sender has been placed on a list of persons entitled to receive the customized message. Claim 37 also recites a set of computer-usable instructions for a computer-implemented method that enable setting user context and a user rule, the user context and the at least one user rule are made available to the user for the modification in accordance with the preferences of the user.

For at least the reasons provided above with regard to independent claim 25, Applicants submit that the proposed combination of Beyda in view of Hinckley fails to teach or suggest each and every limitation of independent claim 37, as amended herein. For instance, the proposed combination of Beyda in view of Hinckley fails to teach or suggest the claimed "set of computer-usable instructions for a computer-implemented method that enable setting a user context and at least one user rule, the user context and the at least one user rule are made available to the user for the modification in accordance with the preferences of the user."

In view of the foregoing, Applicants submit that independent claims 25 and 37 are patentable over the combination of Beyda in view of Hinckley. Similarly, each of claims 26-33, 35, 39-40, and 42-43 depend, either directly or indirectly, from one of allowable independent claims 25 and 37. Further, each of these dependent claims recites other novel and nonobvious features neither taught nor suggested by the cited references in the context of these claims. As such, Applicants submit these claims are also in a condition of allowance, by virtue of their dependency from an allowable independent claim. *See, e.g.*, MPEP § 2143.03.

**D. Beyda in view of Hinckley fails to teach or suggest each and every limitation of rejected claim 17, and therefore fails to support a rejection under 35 U.S.C. § 103(a)**

The Office Action also rejected independent claim 17 as being obvious over Beyda in view of Hinckley. As the proposed combination fails to teach or suggest each and every limitation of amended claim 17, Applicants respectfully traverse this rejection as hereinafter set forth.

Independent claim 17 is generally directed to one or more computer-readable storage media on which are stored machine instructions including instructions for a notification system. The notification system includes a user context process for setting a user context and at least one user rule, the user context and the at least one user rule are made available to a user for modification in accordance with a preference of the user. The notification system also includes a receiving component which receives notifications from a sending component and under specified conditions delivers the notifications to the user. The notification system further includes a registered process. The registered process being a program that has data regarding the user that is outside the data maintained by the other components of the system. Further, when the sending component sends a notification to the receiving component, if the notification is not delivered to the user then a message is sent to the registered process regarding the non-delivery of the notification and wherein a sender who is associated with the sending component is evaluated according to selected criteria to determine whether the registered process will send a customized message to the sender. The evaluation of the sender includes determination of whether or not the sender has been placed on a list of persons entitled to receive the customized message.

In view of the foregoing, Applicants submit that claim 17 is allowable for at least the reasons provided above with regard to claims 1, 9, 25, and 37. For example, the cited

references fail to disclose a “registered process being a program that has data regarding the user that is outside the data maintained by the other components of the system.” Similarly, the cited references fail to disclose a notification system including “a user context process for setting a user context and at least one user rule, the user context and the at least one user rule are made available to a user for modification in accordance with a preference of the user.” Applicants further submit that claims 18 and 20-22 are also allowable by virtue of their dependency from allowable claim 17. *See, e.g.*, MPEP § 2143.03.

**E. Beyda and Hinckley further in view of Cahill to teach or suggest each and every limitation of the independent claims, and therefore fails to support a rejection under 35 U.S.C. § 103(a)**

Claims 5, 21, 31, 33, and 43 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Beyda and Hinckley as applied to claims 1, 17, 25, and 37, and in further view of Cahill. As the Beyda, Hinckley, and Cahill references, either alone or in combination, fail to teach or suggest all of the claim limitations of claims 1, 17, 25, and 37, Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 5, 21, 31, 33, and 43 depend, either directly or indirectly, from one of independent claims 1, 17, 25, and 37, which claims were discussed hereinabove. As previously set forth, Beyda in view of Hinckley fails to teach or suggest each and every element of claims 1, 17, 25, and 37 and, accordingly, fails to teach or suggest all of the limitations of claims 5, 21, 31, 33, and 43 for at least the above-cited reasons. Further, it is respectfully submitted that the Cahill reference fails to cure the stated deficiencies of the Beyda and Hinckley combination. Rather, the Cahill reference describes teaches a system for sending a response to a message without requiring intervention of the message addressee. *See* Cahill, at Abstract. It is respectfully submitted, however, that the Cahill reference does not fairly teach or suggest those

features of amended independent 1, 17, 25, and 37 stated to be deficient in the combination of the Beyda and Hinckley references.

Each of claims 5, 21, 31, 33, and 43 depend, either directly or indirectly, from amended independent 1, 17, 25, and 37, and are therefore patentable over the Beyda, Hinckley, and Cahill references for at least the reasons cited above. Moreover, claims 5, 21, 31, 33, and 43 recite further novel and non-obvious features neither taught nor suggested in the cited references in the context of these claims. Accordingly, Applicant respectfully requests withdrawal of the § 103(a) rejections of claims 5, 21, 31, 33, and 43. Claims 5, 21, 31, 33, and 43 are believed to be in condition for allowance, and such favorable action is respectfully requested.

### **CONCLUSION**

For at least the reasons stated above, claims 1-2, 4-6, 9-12, 14-15, 17-18, 20-22, 25-33, 35, 37, 39-40, and 42-43 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or [ahankel@shb.com](mailto:ahankel@shb.com) (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/s/ Aaron E. Hankel /

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